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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,515	02/04/2000	Howard G. Page	1285	8911
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EXAMINER				
RETTA, YEHDEGA				
ART UNIT		PAPER NUMBER		
3622				
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03/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### DETAILED ACTION

1. This office action is in response to communication filed on 01/07/08.
2. Claims 1-27 have been cancelled. Newly submitted claims 28-41 are withdrawn from consideration. No claims are presented for examination.
4. Newly submitted claims 28-41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Originally filed claims 1-27 are directed to selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer; inserting the selected video advertising into the video stream that transfers the selected video content to the target viewer; transferring the selected video content to the target viewer over a first transport system and transferring the selected video advertising to the target viewer over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system; and disabling fast-forward capability when the selected video advertising is displayed, classified in class 705, subclass 14.
- II. In contrast the newly added claims 28-41 are directed to transferring a selected video content, a selected video advertising, and insertion points from the video-on-demand system to a target viewer device; at the target viewer device, storing the selected video advertising, transferring the selected video content in a video stream to a display device; and interrupting the transfer of the selected video content in the video stream, inserting the stored selected video advertising into the video stream, and resuming the transfer of the selected video content in the video

stream at the insertion points in the selected video content, classified in class 705, subclass 14.

Inventions of groups I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group II has separate utility such as at the target viewer device, storing the selected video advertising, transferring the selected video content in a video stream to a display device; and interrupting the transfer of the selected video content in the video stream, inserting the stored selected video advertising into the video stream, and resuming the transfer of the selected video content in the video stream at the insertion points in the selected video content, which does not involve inserting the selected video advertising into the video stream that transfers the selected video content to the target viewer; transferring the selected video content to the target viewer over a first transport system and transferring the selected video advertising to the target viewer over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system; and disabling fast-forward capability when the selected video advertising is displayed. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 28-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**Response to Amendment - NON-RESPONSIVE AMENDMENT**

The reply filed on 1/7/08 is not fully responsive to the prior Office Action and the BPAI Decision because of the following omission(s) or matter(s):

(1) the "Amendment" filed on 01/07/2008 cancelled all claims drawn to the elected invention (i.e., elected by original presentation and presented to the BPAI) and presented only claims drawn to a non-elected invention and this is non-responsive (see the Manual of Patent Examining Procedure (MPEP) § 821.03).

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

The examiner notes that since the "Amendment" of 01/07/2008 was found to be NON-RESPONSIVE, it has not been entered. Therefore, at present the claims remain as presented in the "Original Set of Claims" filed on 01/5/2006. Any "Amendment" that Applicants now file should either reinstate claims 1-27 (as "original", "currently amended", or "previously presented") or add only new claims to the subject matter originally presented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/

Primary Examiner, Art Unit 3622